

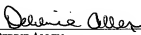
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: §
REDDY ET AL. § Group Art Unit: 1755
Serial No.: 10/759,678 §
Filed: JANUARY 16, 2004 § Examiner: PAUL D. MARCANTONI
Title: "SETTABLE FLUIDS COMPRISING §
PARTICLE-SIZE DISTRIBUTION- §
ADJUSTING AGENTS AND § Atty. Docket No: HES 2003-IP-011937U1
METHODS OF USE" §

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MPEP 503

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal and the applicable fee. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

In a Final Office Action dated July 13, 2007 ("Final Office Action"), the Examiner improperly rejected claims 1-28, 30-39 and 123-191 under 35 U.S.C. § 102(a) and (b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,393,939 to Smith et al. ("Smith"), U.S. Patent No. 3,508,407 to Booth ("Booth") alone or in view of U.S. Patent No. 5,588,488 to Vijn et al. ("Vijn"), U.S. Patent No. 6,087,418 to

Yamashita ("*Yamashita*"), U.S. Patent No. 6,089,318 to Laramay et al. ("*Laramay*"), Scheetz et al. (abstract) ("*Scheetz*"), or U.S. Patent No. 4,131,480 to McCurrich ("*McCurrich*"). The Examiner maintained these rejections in an Advisory Action dated September 25, 2007 ("*Advisory Action*"). The rejections of claims 1-28, 30-39 and 123-191 contain clear legal and factual deficiencies.

Independent claims 1, 123 and 159, from which the remainder of the claims depend, have two elements that are salient to this pre-appeal brief: a particle-size distribution-adjusting agent that comprises a cationic polymer and the step of permitting the resulting cement composition to remain in a *slurry state* for a period of time prior to being *activated*. Claims 123 and 159 further require that the cement composition remain in a slurry state for at least 24 hours and two weeks, respectively. The Examiner's rejections are legally deficient because neither *Smith* nor *Booth*, alone or in combination with any of the many references cited by the Examiner, disclose or suggest cement compositions that comprise particle-size distribution agents that comprise a cationic polymer or teach that the cement composition can remain in a *slurry state* for a period of time before being activated. Thus, independent claims 1, 123, and 159 are allowable over the cited references. Since claims 2-28, 30-39, 124-158 and 160-191 depend, either directly or indirectly, from claim 1, 123 and 159, these dependent claims are allowable for at least the same reasons.

1. ***Smith* nor *Booth* Anticipate Applicants' Claims Because the Particle-Size Distributing Agent Does Not "Necessarily" Comprise a Cationic Polymer or Permit the Cement Composition to Remain in Slurry State for a Period of Time Before Activation.**

Smith does not disclose a particle-size distributing-agent that comprises a cationic polymer as claimed in independent claims 1, 123 and 159, from which the remainder of the claims depend. Recognizing this, the Examiner relies on a theory of inherent anticipation based on the assumptions that the "prior art cationic polymer is the same as Applicants' cationic polymer and thus would also function as their particle size distributing agent." (Final Office Action at page 3.) This is incorrect.

To inherently disclose an element of a claim, "the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a

given set of circumstances is not sufficient.” MPEP at § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)). In fact, the “polacrylamide” particle-size distribution agents disclosed in *Smith* cannot comprise a cationic polymer. *Smith* guards against using cationic organic polymers in conjunction with its polyacrylamide particle-size distribution agents:

cationic organic polymer will normally be *incompatible* with additives . . . such as in substantially hydrolyzed polyacrylamides or polyacrylic acid used to reduce the fluid loss from the slurry . . . often used to retard the setting of cement.

(See *Smith* at col. 4, ll. 17-27.) (emphasis added). Thus, *Smith* cannot inherently anticipate independent claims 1, 123 and 159. Similarly, *Smith* cannot inherently anticipate the claims that depend from these claims.

Furthermore, neither *Smith* nor *Booth* disclose or suggest a method of cementing comprising “permitting the cement composition to remain in slurry state for a period of time prior to cement composition being activated.” Moreover, the Examiner’s characterization of “water” as reading upon the activator or activating agent is without basis, and does not provide an accurate view of the claims in view of the specification. See *Philips v. AWH Corp.*, 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (en banc). Applicants’ Specification, for example, provides a variety of representative activator compositions, which generally comprises a mixture of at least one alkali or alkaline earth metal hydroxide, and a trialkanolamine. (See Specification at 0033.)

Accordingly, for at least these reasons, neither *Smith* nor *Booth* can be used to anticipate independent claims 1, 123 and 159. Similarly, *Smith* cannot inherently anticipate the claims, namely claims 2-28, 30-39, 124-158 and 160-191, that depend from these claims.

2. *Smith* and *Booth*, Either Alone or in Combination, in View of *Vijn*, *Yamashita*, *Laramay*, or *Scheetz* Do Not Obviate Applicants’ Claims Because the Particle-Size Distributing Agent Does Not “Necessarily” Comprise a Cationic Polymer or Permit the Cement Composition to Remain in Slurry State for a Period of Time Before Activation.

Just as *Smith* and *Booth* fail to disclose the methods of permitting the cement composition to remain in slurry state for a period of time before activation as recited in independent claims 1, 123 and 159, *Vijn* also does not, either expressly or inherently, disclose this element of these claims. Further, there is absolutely no reference in *Vijn* that would teach or suggest a particle-size distributing-agent that comprises a cationic polymer as required by independent claims 1, 123, and 159.

Ignoring the fact that *Vijn* does not teach a particle-size distributing-agent that comprises a cationic polymer, the Examiner relies on some notion of inherent anticipation to extrapolate from *Vijn* that “the use of a retarder is *conventional* and well known in cement compositions to retard or delay the setting of cement.” (Final Office Action at pages 3-4.) *Vijn*, however, discusses the use of set retarders to retard *activated* cement compositions for the purpose of preventing “shocks and impacts from subsequent drilling and completion operations carried out in the well” from shattering the cement. (See col. 3, lines 24-35 and col. 5, lines 38-59.) As one skilled in the art would appreciate, conventionally *activated* cement compositions are used down hole for the purpose of setting into a “high strength, impact resistant solid mass between the casing and liners.” (See col. 1, lines 50-60.) Thus, *Vijn* does not disclose “permitting the cement composition to remain in slurry state for a period of time *prior to the cement composition being activated*” as required by claims 1, 123, and 159. (emphasis added) The use of set retarders prior to activation permits large volumes of cement compositions to remain in storage for a required period of time. (See Applicants’ Specification at 0003.) Because *Vijn* fails to disclose this element of the Applicants’ claims, for at least this reason, *Vijn* cannot anticipate or obviate Applicants’ claims, alone or in combinations with *Smith* or *Booth*.

3. Yamashita, Laramay, Scheetz, and McCurrich Do Not Provide the Missing Recitations

Neither *Yamashita*, *Laramay*, *Scheetz*, or *McCurrich* can be used in combination with *Smith* or *Booth* to anticipate or obviate Applicants’ claims. As discussed above with *Smith* and *Booth*, these references do not disclose a particle-size distributing-agent that comprises a cationic polymer as required by independent claims 1, 123, and 159. *Yamashita*, *Laramay*, *Scheetz*, nor *McCurrich*, either expressly or inherently, disclose a particle-size distributing-agent that comprises a cationic polymer. Moreover, there is no reference to any teaching or suggestion which would provide the required recitation.

Additionally, as discussed above with respect to *Vijn*, *Yamashita*, *Laramay*, *Scheetz*, and *McCurrich* fail to disclose “permitting the cement composition to remain in slurry state for a period of time *prior to the cement composition being activated*.” (Claims 1, 123, 159.) The use of set retarders prior to activation permits large volumes of cement compositions to remain in storage for a required period of time. (See Applicants’ Specification at 0003.) The use of set retarders in conventional cementing permits the placing of an *activated* cement composition at a particular location before premature gelling or thickening can affect its placement. (*Id.* at 0004)

Because *Yamashita*, *Laramay*, *Scheetz*, and *McCurrich* fails to disclose this element of the Applicants' claims, for at least this reason, *Yamashita*, *Laramay*, *Scheetz*, and *McCurrich* cannot anticipate or obviate Applicants' claims 1-28, 30-39, and 123-191, alone or in combination with *Smith*. or *Booth*.

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same.

Applicants believe that there are no fees due in association with this Request. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0359, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

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Date: January 10, 2008